



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,158.	01/15/2002	Yosato Hitaka	03500.016099	8868

5514 7590 11/14/2006

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

MENBERU, BENIYAM

ART UNIT PAPER NUMBER

2625

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/045,158	Applicant(s) HITAKA, YOSATO	
	Examiner Beniyam Menberu	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2006.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 20-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 29, 2006 has been entered.

***Response to Arguments***

2. Applicant's arguments filed August 4, 2006 have been fully considered but they are not persuasive.

Kemp et al (U.S. Patent Application Publication 2002/0078160) does disclose on a user apparatus side, forming screen information on the basis of the print shop information of the candidate print shops and the obtained print setting so that the formed screen information indicates whether each print shop of the print shop information of the candidates is selectable or not (page 6, paragraph 62; page 7, paragraph 75 ("print option" reads on "print setting"), paragraph 76, 77; page 8 paragraph 83) accepting a designation of selecting print shop information from the print shop information displayed on the basis of the formed screen information (page 8,

Art Unit: 2625

paragraph 78-82), and forming the print order, including the designation of a selected print shop (page 8, paragraph 82).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 20-28 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2002/0078160 to Kemp et al.

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 20, 25, and 27, Kemp et al disclose a user apparatus that communicates with a print management apparatus via a network (page 4 paragraph 48), comprising:

using condition transmitting means for transmitting using conditions to the print management apparatus (page 5, paragraph 58-61);

print shop information obtaining means for obtaining print shop information of candidate print shops from said print management apparatus in accordance with said using conditions (page 6, paragraph 62-67);

print setting obtaining means for obtaining a print setting to be included in a print order (page 6, paragraph 67, page 7 paragraph 68-72);

screen information forming means for forming screen information on the basis of the print shop information of the candidate print shops and the obtained print setting so that the formed screen information indicates whether each print shop of the print shop information of the candidates is selectable or not (page 6-7, paragraph 62-72; page 8, paragraph 83);

selection accepting means for accepting a designation of selecting print shop information from the print shop information displayed on the basis of the formed screen information (page 6, paragraph 62); and

print order forming means for forming the print order, including the designation of a selected print shop (page 6-7, paragraph 67-74).

Regarding claims 23, 26, and 28, Kemp et al disclose a print management apparatus that communicates with a user apparatus via a network (page 4 paragraph 48), comprising:

using condition receiving means for receiving using conditions from said user apparatus (page 5, paragraph 58-61);

print shop information searching means for searching print shop information of candidate print shops in accordance with the received using conditions (page 6, paragraph 61-67);

candidate print shop transmitting means for transmitting print shop information of candidate print shops searched by the print shop information searching means to said user apparatus (page 6, paragraph 62); and

a print order receiving means for receiving a print order, including a designation of a selected print shop, from said user apparatus (page 6-7, paragraph 67-72),

wherein the designation of the selected print shop included with the print order is selected in the user apparatus from screen information formed on the basis of the print shop information of the candidate print shops transmitted to the user apparatus and a print setting obtained by the user apparatus so that the formed screen information indicates whether each print shop of the print shop information of the candidates is selectable or not so as to promote selection of a print shop which is allowed to output the print order (page 6-7, paragraph 62-73; page 8, paragraph 83).

Regarding claims 24, Kemp et al disclose an information processing system for processing information between a user apparatus and a print management apparatus through communication via a network (page 4 paragraph 48),

wherein said print management apparatus comprises:

using condition receiving means for receiving using conditions from said user apparatus (page 5, paragraph 58-61);

print shop information searching means for searching print shop information of candidate print shops in accordance with the received using conditions (page 6, paragraph 61-67); and

candidate print shop transmitting means for transmitting print shop information of candidate print shops searched by the print shop information searching means to said user apparatus (page 6, paragraph 62), and

wherein said user apparatus comprises:

print setting obtaining means for obtaining a print setting to be included in a print order (page 6, paragraph 67, page 7 paragraph 68-72);

screen information forming means for forming screen information on the basis of the print shop information of the candidate print shops transmitted by the candidate print shop transmitting means and the obtained print setting so that the formed screen information indicates whether each print shop of said print shop information of the candidate print shops is selectable or not (page 6-7, paragraph 62-72; page 8, paragraph 83);

selection accepting means for accepting a designation of selecting print shop information from the print shop information displayed on the basis of the formed screen information (page 6, paragraph 62); and

a print order forming means for forming the print order, including the designation of a selected print shop (page 6-7, paragraph 67-74).

Regarding claim 21, Kemp et al teaches all the limitations of claim 20. Further Kemp et al discloses a user apparatus according to claim 20, wherein the screen information forming means forms the screen information so that a selectable print shop is displayed and a non-selectable print shop is not displayed (pages 3-4, paragraph 40-45; pages 8-9, paragraph 84-86).

Regarding claim 22, Kemp et al teaches all the limitations of claim 20. Further Kemp et al discloses a user apparatus according to claim 20, wherein the print order forming means further forms the print order on the basis of print target data formed by an application (page 4, paragraph 46-50; pages 7-8, paragraph 75-77).

#### **Other Prior Art Cited**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



U.S. Patent No. 7031929 to Button et al disclose printing using plurality of print shops.

U.S. Patent Application Publication Pub. No. US 2003/0061178 A1 to Ogawa discloses printing using plurality of print providers.

U.S. Patent Application Publication Pub. No. US 2004/0034727 A1 to Watanabe et al disclose printing over network.

U.S. Patent No. 7126706 to Taniguchi discloses selection of printing location.

### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beniyam Menberu whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

Art Unit: 2625

applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Patent Examiner**

Beniyam Menberu

BM

11/09/2006

*KAWilliams*

**KIMBERLY WILLIAMS  
SUPERVISOR PATENT EXAMINER**